UNITED STATES PATENT AND TRADEMARK OFFICE

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10/632,072	07/31/2003	Patrick G. McGowan	RSW920030088US1	2034

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EXAMINER
WHIPPLE, BRIAN P

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte PATRICK G. McGOWAN,
CHRISTOPHER J. PAUL, and RICHARD REDPATH

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Appeal 2009-006634
Application 10/632,072
Technology Center 2400

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Decided: April 29, 2010

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Before KENNETH W. HAIRSTON, CARLA M. KRIVAK,
and ELENI MANTIS MERCADER, *Administrative Patent Judges.*

HAIRSTON, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 to 40. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Appellants' invention is concerned with a method, system, and program product for preserving hand-held mobile device user settings by comparing time values of software applications and reconciling files based on that comparison (Spec. ¶¶ [0001], [0004], and [0023]; Abstract). Appellants disclose and claim a system, method, and program product for preserving user preferences including (i) "comparing time values" and reconciling "based on the comparison" in order "to determine whether the client properties have been changed by a user" (claims 1, 15, and 28), and (ii) "reconciling" including retaining "changes made to the client properties file by a user" (claims 8, 22, and 35).

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A method for preserving hand-held mobile device user settings, comprising:

initiating an enterprise application on a mobile device, and reading a client properties file from a device memory of the mobile device into an application memory;

receiving an updated properties file from a server in the device memory;

comparing time values of the updated properties file to time values of the client properties file in the application memory to determine whether the client properties have been changed by a user;

reconciling, based on the comparison, the client properties file and the updated properties file to yield a reconciled properties file; and

writing the reconciled properties file to the device memory.

The Examiner relies upon the following as evidence of unpatentability:

Hesse	US 5,950,010	Sep. 7, 1999
Lenz	US 6,029,196	Feb. 22, 2000
Parkman	US 2003/0046375 A1	Mar. 6, 2003

The following rejections are before us for review:

Claims 1 to 5, 7 to 13, 15 to 18, 20 to 26, 28 to 31, and 33 to 39 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenz in view of Official notice.

Claims 6, 19, and 32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenz and Parkman.

Claims 14, 27, and 40 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenz and Hesse.

The Examiner relies upon Lenz as describing all of the recited features of independent claims 1, 8, 15, 22, 28, and 35 of a system, method, and program product, except for the device being a hand-held mobile device (Ans. 3-5). The Examiner states that mobile and hand-held devices such as phones, laptops, and PDAs were well known at the time of Appellants' invention, and that it would have been obvious to modify the method and system of Lenz with such a feature "to improve mobility and flexibility" (Ans. 5). The Examiner (Ans. 4, 5) then relies upon Lenz as disclosing the recited features of (i) "comparing time values" and reconciling "based on the comparison" in order "to determine whether the client properties have been

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changed by a user" (claims 1, 15, and 28), and (ii) "reconciling" including retaining "changes made to the client properties file by a user" (claims 8, 22, and 35). The Examiner (Ans. 8, 9) also rejects (i) dependent claims 6, 19, and 32, and (ii) dependent claims 14, 27, and 40, applying secondary references to Parkman and Hesse, respectively, while still relying upon Lenz for the same *comparing* and *reconciling* features discussed with respect to independent claims 1, 8, 15, 22, 28, and 35.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In the instant case, the Examiner has not sufficiently established that any of the applied references to Lenz, Parkman, or Hesse discloses or suggests (i) comparing time values and reconciling based on the comparison to determine whether client properties have been changed by a user as set forth in claims 1, 15, and 28, and/or (ii) reconciling including retaining changes made to the client properties file by a user as set forth in claims 8, 22, and 35.

Although Lenz discloses (i) updating files based on a comparison of file version numbers to guarantee the most current version of a software application has been loaded (*see* col. 2, ll. 12-22; col. 4, l. 59 to col. 5, l. 10), and (ii) storing user configurations and preferences on a central server (*see* col. 5, ll. 10-16), Lenz does not describe comparing time values for the purpose of reconciling a client properties file with the updated properties file while retaining user changes to the client properties file.

The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re*

Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006). The Examiner merely asserted that Lenz's column 2, lines 12 to 22, teaches comparing time values of updated properties files to those of client properties files because times are associated with versions. The Examiner has not provided any factual basis or articulated reasoning as to how and why Lenz's suggestion to compare file version numbers (col. 2, ll. 12-21) meets the limitation recited in (i) claims 1, 15, and 28 of comparing time values of, and reconciling, the updated properties files with the client properties file based on the comparison for determining whether the client properties have been changed by a user, or (ii) claims 8, 22, and 35 of reconciling the updated properties file with the client properties file including retaining changes made to the client properties file by a user. Indeed, Appellants' contention (Br. 7-8) that the version of a software application may be completely independent of the time it was created (e.g., hot fixes where changes are made within a specific version and the file has changed even though the version is the same) is convincing.

Appellants are correct (Br. 7, 8) that Lenz discloses comparing file version numbers and not time values (*see* col. 2, ll. 12-22). The Examiner (Ans. 4, 11-12) has not shown that Lenz's column 2, lines 12 to 22, discloses or suggests comparing time values as claimed, and has not otherwise convincingly rebutted Appellants' arguments.

Appellants are also correct (Br. 8) that Lenz discloses making sure the latest *version* of software has been pushed down from the server without determining whether changes in client properties have been made by the user (i.e., user preferences). Appellants' contention (Br. 8, 9) that Lenz does not retain changes to client properties, and instead overwrites them, is

persuasive. As Lenz discloses, "[t]he client replaces the existing files with the new files sent by the server" (col. 2, ll. 14-16). This is not the same as Appellants' reconciliation which involves overwriting updated properties files from the server with a reconciled properties file (¶ [0033]), nor is it the same as comparing time values for reconciling the client properties file with the updated properties file to allow user settings to be preserved (¶ [0035]). Accordingly, we find that Lenz does not "reconcile" in the manner claimed and described by Appellants in the Specification (*see* ¶¶ [0033], [0035]).

Appellants have demonstrated that the Examiner erred in determining that Lenz taken in combination with Official notice discloses or suggests (i) comparing time values of, and reconciling, the updated properties file and the client properties file based on the comparison for determining whether the client properties have been changed by a user as set forth in claims 1, 15, and 28, and (ii) reconciling the updated properties file with the client properties file including retaining changes made to the client properties file by a user as set forth in claims 8, 22, and 35. *See Kahn*, 441 F.3d at 985-86.

Accordingly, we will not sustain the Examiner's rejection of independent claims 1, 8, 15, 22, 28, and 35, or dependent claims 2 to 5, 7 to 13, 16 to 18, 20, 21, 23 to 26, 29 to 31, 33, 34, and 36 to 39, which fall with the respective independent claims from which they depend. For similar reasons, and because Parkman fails to cure the deficiencies of Lenz, we will not sustain the Examiner's rejection of claims 6, 19, and 32, which depend respectively from claims 1, 15, and 28. Likewise, because Hesse also fails to cure the deficiencies of Lenz, we will not sustain the Examiner's rejection of claims 14, 27, and 40, which depend respectively from claims 8, 22, and 35.

In summary, we will not sustain the obviousness rejections of claims 1 to 40 because (i) the Examiner has not established a factual basis to support the legal conclusion of obviousness (*see Fine*, 837 F.2d at 1073), and (ii) the Examiner's articulated reasoning does not support a legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

The decision of the Examiner to reject claims 1 to 40 is reversed.

<u>REVERSED</u>

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